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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,224	03/25/2004	Satoshi Narita	TJK/455	6558

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EXAMINER

FEGGINS, KRISTAL J

ART UNIT PAPER NUMBER

2861

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/809,224

Applicant(s)

NARITA ET AL.

Examiner

K. Feggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-8 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, Examiner is unsure what applicant is claiming, being that claim 6 has method steps and claim 1 is an apparatus claim not a method claim.

Claim 7, Examiner is unsure what applicant is claiming, being that the claim cites the detecting step in an apparatus claim.

Claim Objections

3. Claim 7 recites the limitation "the detecting step" in 6. There is insufficient antecedent basis for this limitation in the claim.

Claims 5-7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 5 is a method claim not an apparatus claim, therefore claim 5 does not contain any new limitations not presented in claim 1.

Claim 6 is a method claim not an apparatus claim, therefore claim 5 does not contain any new limitations not presented in claim 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2 & 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al. (US 5,982,405).

Sasaki et al. disclose the following claimed limitations:

- * regarding claim 1, a sheet for forming an image (Abstract, figs 8-9);
- * a substrate film and two or more image-formative layers disposed thereon, the image-formative layers being defined by frame respectively and arranged in a longitudinal direction of the substrate film (fig 8),
- * wherein an identifying mark (66, 80, 66) having a sequence of mark bits which records information concerning the sheet for forming an image is provided to the sheet for forming an image in a manner of allocating respective mark bits to unit frames each of which comprises a single frame or plural frames of the image-formative layer with the mark bits being arranged in order of the sequence recording the information with at least one cycle period comprising a certain number of the unit frames along with a longitudinal direction of the sheet for forming an image (figs 8-9);

* wherein the sequence of the mark bits constituting the identifying mark is a combination of a sequence of mark bits constituting a first mark A (66, 80) with a sequence of mark bits constituting a second mark B (66), the first mark A having a cycle period (66) of a natural number X, the second mark B having a cycle period same as said X or of a natural number Y different from said X and relatively prime with said X, and the first mark A (66, 80) and the second mark B(66) being different from each other (figs 2 & 3).

* regarding claim 2, wherein the identifying mark is an optically detectable mark, and the first mark A and the second mark B have different optical property for detection (figs 8-9).

* regarding claim 8, wherein the means for detecting the mark bits detects at least one cycle of the mark bits of the identifying mark while carrying the sheet for forming an image to a forward or a reverse direction (figs 8-9).

Allowable Subject Matter

6. Claims 3-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The primary reason for indicating allowable subject matter of 3 is the inclusion of the limitations of a sheet forming image that includes sequence of mark bits

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constituting the identifying mark is a combination of the sequence of mark bits constituting the first mark A, the sequence of mark bits constituting the second mark B, and a sequence of mark bits constituting a third mark C, the third mark C having a cycle period same as the natural numbers X and/or Y or of a natural number Z different from said X and/or Y and relatively prime with said X and Y, and the first mark A, the second mark B (155, 150 and the third mark C being different from each other. It is these limitations found in the claims, as they are claimed in the combination of that has not been found, taught or suggested by the prior art of record, which makes these claims allowable over the prior art.

The primary reason for indicating allowable subject matter of 4 is the inclusion of the limitations of a sheet forming image that includes sequence of mark bits constituting the identifying mark is a combination of at least three sequences of mark bits including those of the mark A and the mark B, each of the sequences constituting a separate series of mark from each other, wherein each mark has a cycle period of a natural number same as any one of the other mark or of a natural number different from every one of the other mark and relatively prime with each other, and the all the marks are different from each other in sequence. It is these limitations found in the claims, as they are claimed in the combination of that has not been found, taught or suggested by the prior art of record, which makes these claims allowable over the prior art.

Communication With The USPTO

Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Feggins whose telephone number is 571-272-2254. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Talbott Dave can be reached on 571-272-1934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 9/05
K. FEGGINS
PRIMARY EXAMINER